



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Knobbe, Martens, Olson & Bear, LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

COPY MAILED

MAR 17 2005

OFFICE OF PETITIONS

In re Application of	:	
Mark W. Miles	:	
Application No. 10/082,397	:	DECISION DISMISSING
Filed: August 6, 2002	:	PETITION
Attorney Docket No. 5652P013XCD	:	

This is a decision on the petition under 37 CFR 1.182 filed November 18, 2004, requesting that the above-identified application be accorded a filing date of February 25, 2002, rather than the presently accorded date of August 6, 2002.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be filed within **TWO MONTHS** of the date of this decision in order to be considered timely (see 37 CFR 1.181(f)). No extensions of time pursuant to the provisions of 37 CFR 1.136 are permitted. If reconsideration is not requested within the time period specified above, this application will be forwarded to Technology Center 2800 for review of the amendment filed November 8, 2004, with the presently accorded filing date of August 6, 2002.

On May 31, 2002, the Office mailed a Notice of Omitted Items in a Nonprovisional Application (Notice) stating that drawing Figure 23E had been omitted from the original filing. The Notice permitted applicant three options for response: (1) to disagree with the Office that the drawing figure was omitted and provide evidence to prove the Office received the omitted item; (2) to submit the omitted item and accept a later filing date based on the day the omitted item was received; or (3) to accept the application as filed without the omitted item. Petitioner chose option (2) by submitting a response to the Notice (with the omitted drawing figure) via certificate of mailing on July 31, 2002, which was received in the Office on August 6, 2002, as petitioner admits in the instant petition. As a result, the Office accorded the application a filing date of August 6, 2002.

Petitioner now requests that the filing date of the application be restored to its original date of February 25, 2002, by withdrawing the response to the Notice received on August 6, 2002. Petitioner asserts that changing the filing date from February 25, 2002 to August 6, 2002, "may be prejudicial to Applicant."

Petitioner voluntarily accepted the later filing date upon submission of the missing drawing figure and \$130 petition fee on August 6, 2002. A review of the file record shows that petitioner filed a Request for Corrected Filing Receipt on May 19, 2003. However, petitioner did not request the earlier filing date at that time, but only requested correction of the assignee information. It is uncertain why petitioner waited two (2) years to file the instant request, considering the application has been examined, was under final office action at the time of filing the present petition, and is currently under appeal. Did petitioner not realize accepting the later filing date would be "prejudicial to the Applicant" before application was prosecuted? The first Office action from the Examiner was not mailed until May 29, 2003. In view thereof, petitioner had ample time, over nine (9) months, to determine and notify the Office that Drawing Figure 23E was not needed for this application.

37 CFR 1.182 states:

"All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, **subject to such other requirements as may be imposed**, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h)." (**Emphasis added**)

The Director is using his discretion to impose other requirements, as noted above in 37 CFR 1.182. Petitioner may obtain favorable relief, upon request for reconsideration, if petitioner submits a Request for Continued Examination (RCE) under the provisions of 37 CFR 1.114, along with an amendment deleting any reference to Figure 23E in the specification, along with any other reply needed to continue prosecution as the nature of the case then admits. No further petition fee is required.

Petitioner should also note that as the period of adjustment of the term of a patent under § 1.703(a) through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application. If the filing date is changed to the original date of deposit, such may impact any patent term adjustment.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By facsimile: (703)-972-9306
 Attn: Office of Petitions

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to Marianne Jenkins at (571) 272-3223.

A handwritten signature in black ink, appearing to read "Brian Hearn". The signature is fluid and cursive, with a large initial "B" and a stylized "H".

Brian Hearn
Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy